

REMARKS

Reconsideration of the present application is respectfully requested.

Summary of Office Action

Claims 1-4, 6, 8-19, 21-37, 39-49, 51, 52, 57-66 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,986,018 of O'Rourke et al. ("O'Rourke") in view of US Patent No. 6,134,588 of Guenther et al. ("Guenther").

Summary of Response

Applicant respectfully traverses all rejections. Claims 1, 15, 23, 26, 32, 37, and 49 have been amended. Claims 34-36, 64, 47-48, 58, and 66 have been canceled. No new matter has been added.

Interview Summary

A telephonic interview was conducted between the Applicant's representative (the undersigned) and Examiner Lin on 04/21/2009. Independent claim 1 was discussed relative to the cited references in the § 103 rejections. The parties did not reach any particular agreement.

Response to Rejections Related to 37 CFR 1.131

Applicant previously submitted a declaration under 37 C.F.R. § 1.131 along with the response filed on January 28, 2009. The 37 CFR § 1.131 declaration and accompanying exhibits submitted with the response filed on January 28, 2009 are incorporated by reference herein in its entirety.

I. Conception

The Office indicated that the feature "wherein the host is determined to be available if the host responds to a connection attempt within a timeout period and, if more than one host is available as indicated by said rule, to select the host based on a delivery factor included in said rule" is not disclosed by Exhibit A. (See Office Action, page 3, paragraph 4). The Applicant respectfully disagrees with the Office. However, to expedite prosecution of this Application, Applicant has amended claim 1 to remove the indicated feature. Applicant respectfully submits that Exhibit A discloses all other features of the independent claims (e.g., claim 1) as illustrated below.

Applicant is submitting herewith the following exemplary table in support of the 37 C.F.R. § 1.131 declaration previously filed. The 1.131 declaration includes Exhibits A and B. The following table provides a correlation between Exhibit A and, for example, claim 1. The correlation table is for illustrative purposes only and is not intended to limit the scope of any of the claims.

Exhibit A (Examples only)	Claim 1
<ul style="list-style-type: none"> Figure illustrating overview of request resolution hierarchies, page 183 <ul style="list-style-type: none"> Netcache A is a caching device operating as an intermediary node on a network 	A caching device to operate as an intermediary node on a network, the device comprising:
<ul style="list-style-type: none"> Figure illustrating overview of request resolution hierarchies, page 183 <ul style="list-style-type: none"> Netcache A is a cache to store content 	a cache to store content requestable by a client on the network;
<ul style="list-style-type: none"> Table illustrating "adding or editing custom hierarchy rules," pages 234-236. 	a user interface to enable a user to specify a set of forwarding rules for forwarding requests on the network;
<ul style="list-style-type: none"> Figure illustrating overview of request resolution hierarchies, page 183 <ul style="list-style-type: none"> Netcache A stores hierarchy rules 	a database to store the set of forwarding rules;
<ul style="list-style-type: none"> Figure illustrating overview of request resolution hierarchies, page 183 <ul style="list-style-type: none"> Netcache A receives and processes requests from client 	a request processing unit to receive a request from the client;
<ul style="list-style-type: none"> Figure illustrating overview of request resolution hierarchies, page 183 <ul style="list-style-type: none"> If Netcache A cannot resolve requests, hierarchy rules indicate what to do next Hierarchy rules on Netcache A indicate where send request to (e.g., "send to host," "send direct") Step 2, page 187 "Earth (the child)," page 213 Rules definition, page 217 	a rule evaluator to evaluate the set of forwarding rules to identify within the set of forwarding rules a rule which applies to the request, such that the request processing unit attempts to forward the request to a destination selected according to said rule, wherein the rule indicates a host in a defined forwarding hierarchy; and
<ul style="list-style-type: none"> Figure illustrating overview of request 	a rule engine to determine an availability of

<p>resolution hierarchies, page 183</p> <ul style="list-style-type: none"> ○ Netcache A • Table indicating "planning for hierarchies with multiple members," page 211 <ul style="list-style-type: none"> ○ Load balancing (for a load balancing group) • Benefits of using clusters, page 211 <ul style="list-style-type: none"> ○ Load balancing • Figure illustrating hierarchies with multiple members, load balancing details, page 213 • "About Hierarchy forwarding rules," page 217 • "Elements in a hierarchy rule," page 221-222 • "Execution order of rules," page 222 	<p>the host indicated in said rule and, if the host is available, to select the host as a forwarding destination and to cause the request processing unit to forward the request to the host according to said rule, and wherein, if the request processor is unable to forward the request according to said rule, the rule evaluator resumes evaluating the set of forwarding rules to identify another rule corresponding to the request.</p>
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Based on the exemplary correlation table above, the Applicant respectfully submits that Exhibit A, which is dated prior to June 26, 2001, **shows conception** of the claimed invention **before the effective date of the O'Rourke reference.**

II. Reduction to Practice: ACTUAL REDUCTION TO PRACTICE

Furthermore, Exhibit A, which is an administration guide for a product named "NetCache Appliance 5.0," provides evidence that the claimed invention was implemented in the NetCache Appliance 5.0 product ("Product"). Additionally, Exhibit B provides a listing of release dates of various products released by NetApp, Inc.¹ Applicants have redacted the dates in Exhibit B in accordance with MPEP § 715.07. Applicants submit that the original (unredacted) form of the document in Exhibit B indicates that the Product was released for "[e]arly access" prior to June 26, 2001 (See Exhibit B, page 13 of 16), meaning that the Product, with the present invention included, was operational and was released to end-users for testing and evaluation prior to June 26, 2001. Exhibit B thus provides evidence of **actual reduction to practice** of the claimed invention **before the effective date of the O'Rourke reference**.

Because the claimed invention was conceived and actually reduced to practice prior to the effective date of the O'Rourke reference, Applicant respectfully submits that **O'Rourke is not effective as prior art**. Therefore, Applicant respectfully submits that all rejections based on O'Rourke should be withdrawn.

- Redacted Dates

MPEP § 715.07 provides that "[i]f the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration. When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her

¹ NetApp, Inc. is the assignee of the present invention

actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date."

Additionally, MPEP § 715.07(a) provides that "[w]here conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence." Accordingly, **evidence of diligence is required only when reduction of practice is after the date of the reference.** As indicated above, the invention was actually reduced to practice prior to the effective date of the O'Rourke reference. Therefore, Applicant respectfully submits that **diligence does not have to be established.**

Discussion of § 103 Rejections

Independent claims 1, 15, 23, 26, 32, 37, and 49:

The cited references, either individually or in combination, do not disclose or even suggest such that the destination or host should be selected based on any delivery factors. Although Applicant's arguments shall be directed to the alleged combination of references, it is necessary to first consider their individual disclosures, in order to ascertain what combination, if any, could be made from them.

Applicant maintains the arguments submitted in the response filed on January 28, 2009, which is incorporated by reference herein in its entirety. Even assuming *arguendo* that the features indicated in the Office Action are disclosed by O'Rourke, the Applicant respectfully submits that **O'Rourke is not effective as prior art**, as discussed

above. Likewise, Guenther does not disclose or suggest any of the limitations that are allegedly disclosed by O'Rourke. As such, the cited combination cannot render the claimed invention obvious for at least the reasons indicated herein. Therefore, Applicant respectfully requests the Examiner to find that independent claims 1, 15, 23, 26, 32, 37, and 49, and all claims dependent on the independent claims are thought to be patentable over the cited art.

Applicant has not necessarily discussed here every reason why every pending independent claim is patentable over the cited art; nonetheless, Applicant is not waiving any argument regarding any such reason or reasons. Applicant reserves the right to raise any such additional argument(s) during the future prosecution of this application, if Applicant deems it necessary or appropriate to do so.

Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicant's silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim.

CONCLUSION

In light of the amendments and the preceding arguments, the applicant respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance.

If the Examiner believes that a conference would be of value in expediting the prosecution of this application, he is cordially invited to telephone the undersigned counsel at (650) 838-4300 to arrange for such a conference.

For any required fees, please charge our Deposit Account No. 50-2207, under Order No. 67272-8049.US01 from which the undersigned is authorized to draw.

Dated:

6/10/09

Respectfully submitted,

By

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